

REMARKS

Claims 1-20 are pending. Claims 1, 10 and 15 are amended for clarification. No new matter is introduced.

The present amendment accompanies the RCE filed herewith under 37 C.F.R. § 1.114. Prior to continued examination of the subject application, Applicants respectfully request entry of this amendment. Reconsideration and issuance of a Notice of Allowance are respectfully requested in view of the foregoing amendments and following remarks.

In paragraphs 2 and 3 of the Office Action, claims 1-20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, with respect to independent claims 1, 10 and 15, the Office Action states that the relationship between the “one or more violations” and the “one or more solutions” is unclear. Applicants traverse this rejection and traverse the interpretation of the claims that “one solution [corresponds] to one violation.” *See* Office Action, page 2, paragraph 3-1.

Claims 1-20 are in compliance with 35 U.S.C. § 112, second paragraph, because these claims particularly point out and distinctly claim the subject matter which the applicants regard as the invention. As amended, claims 1, 10 and 15 claim a solutions database that includes “a list containing one or more circuit design violations and one or more solutions...corresponding to the one or more circuit design violations contained in the list.” Support for these features can be found in the specification beginning at page 4, line 8 to page 6, line 5, for example. The relationship between the “one or more circuit design violations” and the “one or more solutions” is clear. Based on the claims, it is clear that a circuit violation can have one or more corresponding solutions. Similarly, it is clear that “one or more solutions” can correspond to “one or more circuit design violations” contained in the list. In reviewing claims for compliance with 35 U.S.C. § 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. § 112. *See* MPEP 2173.02. If the scope of the subject matter embraced by the claims is clear, then the claims comply with 35 U.S.C. § 112, second paragraph. Applicants submit that the scope of the pending claims is clear and claims 1-20 are in compliance with 35 U.S.C. § 112, second paragraph. Applicants request that the present rejection based on 35 U.S.C. § 112, second paragraph, be withdrawn.

In paragraphs 4 and 5 of the Office Action, claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being un-patentable over Toshiba, JP 9-128424 (hereinafter *Toshiba*) in

view of Moerkotte et al., "Reactive Consistency Control in Deductive Databases" (hereinafter *Moerkotte*). These rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See MPEP Section 706.02 (j).*

Applicants respectfully submit that the Office Action does not establish a *prima facie* case of obviousness.

Independent claims 1, 10 and 15 recite, among other features,:

identifying symptoms of the violations of the circuit design specification based on the circuit design being analyzed;

identifying solutions to the violations of the circuit design specification based on the identified symptoms using data in a solutions database, wherein the solutions database includes a list containing one or more circuit design violations and one or more solutions, based on circuit characteristics, corresponding to the one or more circuit design violations contained in the list.

Applicants submit that the applied reference(s) do not disclose or suggest all of the claim limitations as recited in independent claims 1, 10 and 15 (as presented).

The Office Action states at page 3, paragraph 5-1, that "Toshiba fails to expressly disclose identifying symptoms and identifying solutions to the violations based on the symptoms." However, the Office Action states that *Moerkotte* discloses these features. Applicants disagree. *Moerkotte* relates to deductive databases. Specifically, *Moerkotte* relates to treatment of consistency violations in deductive databases. *See Abstract and Introduction.* Nothing in *Moerkotte* discloses or suggests that *Moerkotte* can be applied to a method or system for analyzing a circuit design, as claimed. The sections of *Moerkotte*, cited in the Office Action, do not disclose or suggest identifying symptoms of the violations of the circuit design specification based on the circuit design being analyzed and identifying solutions to the violations based on the identified symptoms, as claimed. Moreover, *Moerkotte* does not disclose or suggest a solutions database that includes a list containing one or more circuit design violations and one or more solutions, based on circuit characteristics, corresponding to the one or more circuit design violations contained in the list, as claimed.

In addition, the Office Action provides no motivation or suggestion, within the references or in the knowledge generally available to one of ordinary skill in the art, to

modify the teachings of *Toshiba*, relating to schematic-capture equipment of a CAD system, with the teachings of *Moerkotte*, relating to deductive databases. Even if *Toshiba* and *Moerkotte* could be somehow combined, the resulting combination would not yield the present invention as claimed.

Based on the above, Applicants respectfully submit that the Office Action fails to establish a *prima facie* case of obviousness, with respect to the claimed invention, as required by the MPEP, Section 706.02 (j). Applicants respectfully submit that independent claims 1, 10 and 15 are patentably distinguishable over the applied art for at least the reasons indicated above and are in condition for allowance.

Claims 2-9 depend from independent claim 1, claims 11-14 depend from independent claim 10, and claims 16-20 depend from independent claim 15. Therefore, claims 2-9, 11-14 and 16-20 are in condition for allowance for the reasons stated above and for the additional features recited therein.

CONCLUSION

In view of the foregoing remarks, favorable reconsideration of all pending claims is requested. Applicants respectfully submit that this application is in condition for allowance and request that a notice of allowance be issued.

It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's deposit account no. 08-2025.

Should the Examiner believe that anything further is required to expedite the prosecution of this application or further clarify the issues, the Examiner is requested to contact Applicants' attorney at the telephone number listed below.

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Respectfully submitted,

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